

REMARKS

Reconsideration of the present application and entry of this amendment are respectfully requested. Claims 1 to 44 are currently pending, and claims 1, 7, 11 and 41 have been amended.

The Office Action mailed December 23, 2003 addressed claims 1 to 44. Claims 1 to 44 were rejected.

Claims 7, 11 and 41 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that in claims 7 and 11, the language "the component" is indefinite as a plurality of components are defined in claim 1, and in claim 41, the language "consequent" is unclear.

Claims 7 and 11 have been amended to recite the "at least one" component, and also to state that the at least one component "is" instead of "includes" to make the language more clear. Claim 1 has also been amended to recite the "at least one" component to be consistent with claims 7 and 11. Claim 41 has been amended to recite "subsequent" instead of "consequent", as suggested by the Examiner. Applicants respectfully submit that this overcomes the rejection of claims 7, 11 and 41 under 35 U.S.C. § 112, second paragraph and request that the Examiner reconsider and withdraw the rejection.

Claims 38 and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sullivan et al. (5,356,941). The Examiner stated that regarding claim 38, Sullivan discloses a process for making a ball comprising a core and cover, wherein the cover is made using a RIM technique by injection of liquid urethane, and regarding claim 44, Sullivan discloses a golf ball comprising a urethane cover.

Applicants respectfully disagree with the Examiner. Sullivan discloses a game ball, such as a softball, but Sullivan does not disclose a golf ball or a RIM process for making a core or cover of a golf ball. Applicants' claims 38 and 44 require that the ball is a golf ball, not a game ball such as a softball. Applicants respectfully submit that the Examiner has mischaracterized the teachings of Sullivan, and Applicants respectfully request that the Examiner reconsider the rejection.

Since, as discussed above, Sullivan does not teach each and every element of Applicants' claims 38 and 44 because Sullivan does not teach a golf ball cover or core formed by RIM, Applicants respectfully submit that Sullivan does not anticipate Applicants' claims. Applicants respectfully request that the Examiner reconsider and withdraw the rejections of claims 38 and 44 as anticipated by Sullivan et al. under 35 U.S.C. § 102(b).

Claims 42 to 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Cavallaro (5,759,676). The Examiner stated that Cavallaro discloses a golf ball comprising a core and a polyurethane cover, wherein the cover has a flex modulus greater than 80,000 psi and a thickness from 0.015 to 0.14 inch. The Examiner concluded that the reaction time and recycled reactants are process/method steps and are not relevant to the final product.

Applicants respectfully disagree with the Examiner. Cavallaro discloses a golf ball having a soft mantle and a hard cover, and the mantle and cover may be formed from a variety of materials including polyurethanes, but Cavallaro does not disclose a golf ball having a core or cover formed by reactants in a reaction time of 5 minutes or less, or a golf ball wherein 5 to 100% of the reactants are obtained from recycled polyurethane/polyurea. Applicants respectfully submit that the reaction time and the recycled reactants are relevant to the final product as they are describing the materials used to make the product, i.e., recycled polyurethane materials and/or fast-chemical-reaction materials. Applicants respectfully request that the Examiner reconsider the rejection.

Since, as discussed above, Cavallaro does not teach each and every element of Applicants' claims 42 to 44, Applicants respectfully submit that Cavallaro does not anticipate Applicants' claims. Applicants respectfully request that the Examiner reconsider and withdraw the rejections of claims 42 to 44 as anticipated by Cavallaro under 35 U.S.C. § 102(b).

Claims 14 to 20, 23, 29 to 34, 37 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941). The Examiner stated that regarding claim 14, Wu discloses polyurethane golf ball parts, but

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Wu does not disclose reaction injection molding. The Examiner further stated that Sullivan teaches a game ball comprising a cover formed by RIM. Claims 15 to 20, 23, 29 to 34, 37 and 40 were variously rejected over Wu and Sullivan. The Examiner concluded that one of ordinary skill in the art would have modified Wu in view of Sullivan by using a RIM process to achieve the desired properties.

Applicants respectfully disagree and submit that the Examiner had not made out a *prima facie* case of obviousness. As stated by the Examiner, Wu does not disclose RIM. As previously stated, Sullivan does not disclose RIM for use on a golf ball, but instead, Sullivan discloses the use of RIM to form a cover of a game ball, such as a softball. Applicants respectfully submit that the Examiner has shown no suggestion or motivation to combine Wu and Sullivan since Wu is directed to golf balls and Sullivan is clearly directed to game balls, such as softballs. There is no teaching in Sullivan that would suggest that using RIM to make a core or cover of a softball would be successful. Applicants respectfully submit that the addition of Sullivan does not cure the deficiency in Wu, that is, Sullivan does not disclose a golf ball core or cover produced by RIM.

For at least these reasons, Applicants respectfully submit that claims 14 to 20, 23, 29 to 34, 37 and 40 are not obvious over Wu in view of Sullivan. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 14 to 20, 23, 29 to 34, 37 and 40 under 35 U.S.C. § 103(a) as obvious over Wu in view of Sullivan.

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941) and Molitor (4,674,751). The Examiner stated that Wu in view of Sullivan does not disclose an ionomer blended with the polyurethane in the cover material, but Molitor teaches a cover made from a urethane and an ionomer. The Examiner concluded that one of ordinary skill in the art would have modified the cover by using an ionomer to improve the durability of the cover.

Applicants respectfully disagree and submit that the Examiner had not made out a *prima facie* case of obviousness. As discussed above, Wu in view of Sullivan does not disclose a golf ball cover produced by RIM. The addition of another reference, Molitor, does not cure this fundamental deficiency. Molitor also does not disclose a golf ball core

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or cover produced by RIM, therefore, the combination of Wu in view of Sullivan and Molitor does not disclose Applicants' claim.

For at least these reasons, Applicants respectfully submit that claim 35 is not obvious over Wu in view of Sullivan and Molitor. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 35 under 35 U.S.C. § 103(a) as obvious over Wu in view of Sullivan and Molitor.

Claims 14, 18, 21, 22 and 24 to 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cavallaro (5,759,676) in view of Sullivan (5,356,941). The Examiner stated that regarding claims 14 and 18, Cavallaro discloses a golf ball comprising a core and a polyurethane cover, but Cavallaro does not disclose reaction injection molding. The Examiner further stated that Sullivan teaches a game ball comprising a cover formed by RIM. Claims 18, 21, 22 and 24 to 28 were variously rejected over Cavallaro and Sullivan. The Examiner concluded that one of ordinary skill in the art would have modified Cavallaro in view of Sullivan by using the RIM process to achieve the desired properties.

Applicants respectfully disagree and submit that the Examiner had not made out a *prima facie* case of obviousness. As stated by the Examiner, Cavallaro does not disclose RIM. As previously stated, Sullivan does not disclose RIM for use on a golf ball, but instead, Sullivan discloses the use of RIM to form a cover of a game ball, such as a softball. Applicants respectfully submit that the Examiner has shown no suggestion or motivation to combine Cavallaro and Sullivan since Cavallaro is directed to golf balls and Sullivan is clearly directed to game balls, such as softballs. There is no teaching in Sullivan that would suggest that using RIM to make a core or cover of a softball would be successful. Applicants respectfully submit that the addition of Sullivan does not cure the deficiency in Cavallaro, that is, Sullivan does not disclose a golf ball core or cover produced by RIM.

For at least these reasons, Applicants respectfully submit that claims 14, 18, 21, 22 and 24 to 28 are not obvious over Cavallaro in view of Sullivan. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 14,

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18, 21, 22 and 24 to 28 under 35 U.S.C. § 103(a) as obvious over Cavallaro in view of Sullivan.

Claims 38 to 41 and 44 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 40, 41, 43, 44 and 48 of copending Application No. 09/877,600.

Applicants respectfully submit that since this is only a provisional rejection, Applicants will amend or cancel the claims when one of the applications is allowed. Applicants respectfully submit that this will overcome the rejection.

Claims 1 to 37, 42 and 43 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 9 to 11, 13, 14, 16 to 39, 46 and 47 of copending Application No. 09/877,600.

Although Applicants respectfully disagree with the Examiner, in an effort to hasten prosecution, Applicants will submit a Terminal Disclaimer which disclaims the terminal portion of any patent granting from the instant applications, as required under MPEP § 1490, once the remaining rejections have been overcome. Applicants respectfully submit that this will overcome the rejection.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

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CONCLUSION

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 1 to 44. Applicants respectfully request allowance of claims 1 to 44, the claims currently pending in the present application.

Respectfully submitted,

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